

REMARKS

Claims 1-8 and 13-20 are pending in the present application.

Claims 9, 11 and 12 are canceled herein.

No new matter is entered by the amendments.

The claims are believed to be allowable for, at least, the reasons set forth herein. Notice thereof is respectfully requested.

Claim Rejections - 35 USC § 102

Claims 1-8 and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0710675 (EP'675).

The Office has cited EP'675 in the first action and again as a final action. Arguments were made in response to the first action detailing the fact that the present invention comprises forming a mixture of cyclodextrin and initiator to which monomer is added. This differs from EP'675 wherein a complex of cyclodextrin and monomer is formed and this complex is then combined with initiator.

The Office further argues that the instant claim does not say anything about the intial presence of cyclodextrin and

initiator in a water system. This argument clearly did not apply to claim 13 yet the rejection under 35 U.S.C.102(b) was applied contrary to the reasoning of the Office. Claim 1 has been amended to clarify the aqueous solution. The rejection is improperly based on the failings of the claim to state that which it clearly does, in fact, state.

EP'675 is argued by the Office to teach addition of the initiator prior to addition of the monomer. EP'675 does not teach an aqueous solution of cyclodextrin and initiator to which a monomer is added.

The rejection of claims 1-8 and 13-20 under 35 U.S.C. 102(b) is improper due to the failure of the reference to teach elements of the claim. Therefore, removal of the rejection is respectfully requested.

Claim Rejections - 35 USC § 103

Claims 1-8 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rimmer et al. (Polymer, 40(1999), 6673-77), hereinafter Rimmer.

Rimmer is cited as disclosing a suspension or emulsion polymerization of BMA in the presence of cyclodextrin in the

presence of initiator. This combination is then incorrectly cited as rendering the present invention unpatentable.

Rimmer specifically teaches formation of a monomer/cyclodextrin complex. The cyclodextrin is added to a flask with other materials. The monomer is then slowly added and the system allowed to equilibrate for 30 minutes. Based on the teaching of Rimmer the result is a complex of cyclodextrin and monomer. One of skill in the art would consider this crucial based, in part, on the introduction wherein the advantage of formation of the complex is set forth to be understood in the art. After the complex is formed an initiator is added and the polymerization proceeds.

In the present invention the cyclodextrin and initiator are first introduced into an aqueous solution. Monomer is added to the aqueous solution of cyclodextrin and initiator. It is inconceivable that the complex described by Rimmer could form, especially since it requires 30 minutes to equilibrate. One of ordinary skill in the art would not eliminate the critical step of forming a complex as set forth in Rimmer.

Rimmer teaches contrary to the instant invention and, only in hindsight, would one consider going contrary to Rimmer in deference to the teachings therein.

The Office has argued that continuous operation would have been obvious in light of a batch process. This argument is without merit and can only be made if one assumes, *arguendo*, that a complex of cyclodextrin and monomer is made in both cases. Absent some reference to the contrary, the batch process involves initial formation of a complex while the process of the present claim cannot be considered to make the same complex under the reaction conditions. Mixing ingredients is *prima facie* obvious only if the reaction created thereby is the same. In the instant claims the intermediate described in Rimmer is not formed to any appreciable degree and therefore the order of mixing proceeds along a different reaction path.

The criticality of the order in Rimmer is clearly on the record. The critical step is the formation of a complex. Without the complex being formed the teachings of Rimmer are ignored. If the order is changed the entire reaction is changed. The present invention does not merely reverse steps,

as argued by the Office, but instead eliminates a step which is necessary under the teachings of Rimmer.

The rejection of claims 1-8 and 13-20 is improperly based on teachings which are contrary to the presently claimed invention. Removal of the rejection of claims 1-8 and 13-20 under 35 U.S.C.103(a) as being unpatentable over Rimmer et al. is respectfully requested.

Claims 1-8 and 13-20 are rejected under 35 U.S.C.103(a) as being unpatentable over Storsberg et al. (Macromol. Rapid Communications, 2000, 21, 236-41) herinafter Storsberg'1.

Storsberg'1 is cited using similar logic to that set forth for Rimmer. Storsberg'1 specifically describes polymerization of a cyclodextrin complexed monomer as set forth in the title, in the introduction and throughout the specification. One of skill in the art would not consider Storsberg'1 only to ignore those teachings and eliminate formation of the very complex the teachings are based on.

The rejection of claims 1-8 and 13-20 are based on a reference which is contrary to the presently claimed invention and is therefore improper.

Removal of the rejection of claims 1-8 and 13-20 under 35 U.S.C. 103(a) as being unpatentable over Storsberg'1 is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. 102(a) or 102(b) as anticipated by or, in the alternative, under 103(a) as obvious over any one of the above references, each one individually.

Claim 9 has been canceled and all rejections directed thereto are moot.

CONCLUSIONS

Claims 1-8 and 13-20 are pending in the present application. All claims are in believed to be condition for allowance. Notice thereof is respectfully requested.

April 7, 2004

Respectfully submitted,

Joseph T. Guy, Ph.D.
Agent for Applicants
Registration Number 35,172
NEXSEN PRUET ADAMS KLEEMEIER LLC
P.O. Box 10648
Greenville, SC 29603
Telephone: 864-370-2211
Facsimile: 864-282-1177